



1634

PATENT APPLICATION
Attorney Docket No. 45687-00060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Liang et. al.

§ Art Unit: 1634

Serial No.: 09/909,333

§ Examiner: Forman, Betty J..

Filed: July 19, 2001

§

Title: Method of Preparing Nucleic Acid
Microchips

§
§
§

Commissioner for Patents
Washington, DC 20231

Dear Sir:

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TECH CENTER 1600/2900

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on September 23, 2002.

Printed Name: Lekha Gopalakrishnan

Lekha Gopalakrishnan

Signature

TRANSMITTAL LETTER

Transmitted herewith in the above-identified application are:

- 1) Response to Office Communication Mailed August 23, 2002;
- 2) Acknowledgment Postcard

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account 10-0447 (Reference No. 45687-00060).

PATENT APPLICATION
Attorney Docket No. 45687-00060

Respectfully submitted,



Lekha Gopalakrishnan
Reg. No. 46,733

Date: September 23, 2002

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PATENT APPLICATION
Attorney Docket No. 45687-00060

#9
Response

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Lekha Gopalakrishnan
Signature

RESPONSE TO OFFICE COMMUNICATION MAILED AUGUST 23, 2002

In response to the office communication mailed August 23, 2002, Applicants respectfully respond as follows:

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. § 121

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a method for preparing a nucleic acid microchip, classified in class 536, subclass 23.1
- II. Claims 18-34, drawn to a nucleic acid microchip, classified in class 435, subclass 287.2.

Examiner states that the inventions are distinct, each from the other because:

Inventions I and II are related as a process of making and the product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.04(f)). In the instant case the product as claimed can be made by

another and materially different processes e.g. the microchip can be made by chemical synthesis; the microchip can be made by creating a mother plate comprising double-stranded nucleic acids, adding a denaturing solution to the mother plate and transferring via pipette denatured nucleic acids from the mother plate onto a daughter plate.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Office Action of May 22, 2002, page 2.

Applicants respectfully respond as follows:

Applicants elect the claims in Group I with traverse, *i.e.*, claims 1-17, drawn to a method for preparing a nucleic acid microchip. In the Response to Office Action filed on June 21, 2002, Applicants have amended claim 18 such that the product as claimed *i.e.*, the nucleic acid microchip, is made by the method of claim 1. Therefore, the instant claims 1-34 now read on a process that is used to make a specific product, and the product as claimed is made by a specific process. As such, the inventions are no longer distinct and therefore, restriction is not proper.

In addition, Applicants respectfully request the Examiner to reconsider the restriction requirement between Group I and Group II for the reason that there is no additional burden to search and examine the two groups of claims.

The claims of Group II depend upon claims 1 and 18 (as previously amended), either directly or indirectly. The search and examination can proceed on the basis of claim 1 Group I. As such, there is no additional burden on the part of the Patent Office to keep claims 18-34 together with claims 1-17. Moreover, according to MPEP § 803, if the search and examination of patent claims can be made without serious burden, the examiner **must** examine it on the merits, **even though the application includes claims to independent or distinct inventions.** (*emphasis added*).

For these reasons, Applicants respectfully request the withdrawal of the restriction requirement between Groups I and II.

CONCLUSION

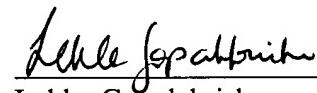
The Applicants have addressed all of the Examiner's rejections. If any questions or issues remain

in the resolution of which the Examiner feels will be advanced by a conference with the Applicants' attorney, the Examiner is invited to contact the attorney at the number noted below.

The one-month period expires on September 23, 2002. Since this Response is being filed within the one-month time limit, no extension of time is necessary. Therefore, no fees are due as a result of this Response. The Assistant Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account 10-0447, reference number 45687-00060.

Respectfully submitted,

JENKENS & GILCHRIST,
A Professional Corporation



Lekha Gopalakrishnan
Reg. No. 46,733

Date: September 23, 2002

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